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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,700	05/25/2001	Renaud Mariana	T2146-907272	2286

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MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER
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EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/856,700

Applicant(s)

MARIANA, RENAUD

Examiner

Hussein A El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) \*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to application filed on May 25, 2001. Claims 1-16 were canceled. Claims 17-32 were newly added.

### *Drawings*

2. Official drawings are required to be submitted by the applicant.

### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of

the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

3. The specification does not include headings for the parts of the specification e.g. "summary of the invention, detailed description of the drawings".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "it" in 9<sup>th</sup> line of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 17-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawan et al., U.S. Patent No. 6,745,247 (referred to hereafter as Kawan).

As to claim 17, Kawan teaches a method for remote control of a user station using a smart card via an internet-type network, said user station being equipped with a smart card reader and comprising a first communication protocol stack, said smart card reader comprising a second communication protocol stack and said smart card comprising a third communication protocol stack, allowing communications between said user station and a remote server connected to said network and communications between said user station and said smart card via said smart card reader, said user station also comprising means for generating requests transmitted to said remote server, characterized in that it comprises:

- storing (42) in said remote server (4) data and/or instructions in a first preliminary phase for allowing the generation of specific commands upon reception of specific requests originating from said request generating

means (10) and their transmission to said user station (1) (see col. 2 lines 25-50);

- loading into said user station (1) a second preliminary phase in a piece of specialized software (8) forming an interface between said first and second protocol stacks and designed to translate said specific commands received by said user station (1) into commands that conform to a first given communication protocol (see col. 2 lines 51-col. 3 lines 37);

- and at least the following steps:

a/ transmitting to said remote server at least one specific request (see col. 2 lines 51-col. 3 lines 37),

b/ generating by said remote server (4), upon reception of said specific request, at least one of said specific commands and transmitting said at least one of said specific commands to said user station (1) using a second given communication protocol (see col. 2 lines 51-col. 3 lines 37);

c/ receiving said specific command in said user station (1), intercepting said piece of specialized software (8) and translating said piece of specialized software into said first given communication protocol (see col. 2 lines 51-col. 3 lines 37);

d/ using said first given communication protocol to transmit said translated command to said smart card (2), via said smart reader (3) (see col. 2 lines 51-col. 3 lines 37), and

e/ activating at least one given function of at least one application (26) stored in said smart card (2), by said translated command in order to perform said control of the user station (see col. 2 lines 51-col. 3 lines 37).

As to claim 18, Kawan teaches a method according to claim 17, characterized in that said data and/or instructions stored in said remote server (4) and allowing the generation of specific commands comprise smart card context data, said context data being a representation, in the memory of said remote server (4), of said smart card (2) present in said user station (1) (see col. 2 lines 51-col. 3 lines 37).

As to claim 19, Kawan teaches a method according to claim 18 characterized in that, said smart card (2) is controlled by an operating system associated with a version number, and said context data comprises at least said version number of the operating system (see col. 2).

As to claim 20, Kawan teaches a method according to claim 17, characterized in that said specific commands are the result of the execution of a CGI type script in said remote server (4) (see col. 3-col. 4).

As to claim 21, Kawan teaches a method according to claim 17, characterized in that said piece of specialized software (8) is loaded into said user station (1) during said first preliminary phase, from a data recording medium (see col. 2 lines 51-col. 3 lines 37).

As to claim 22, Kawan teaches a method according to claim 17, characterized in that said piece of specialized software (8) is downloaded into said user station (1) during



said a first preliminary phase, from a remote server, via said internet network (RI) (see col. 2 lines 51-col. 3 lines 37).

As to claim 23, Kawan teaches a method according to claim 17, characterized in that said first given communication protocol is of the TCP/IP type (see col. 2 lines 35-50).

As to claim 24, Kawan teaches a method according to claim 17, characterized in that said second given communication protocol conforms to ISO standards 7816-1 through 7816-4 (see col. 2 lines 25-50).

As to claim 25, Kawan teaches a method according to claim 17, further comprising, subsequent to activating said at least one given function, the steps of:

f/ transmitting data and/or instructions between said smart card (2) and said terminal (1), via said smart card reader (3), said transmission being performed using said first given communication protocol;

g/ translating said data and/or instructions by said piece of specialized software (8) and its transmission to said remote server (4), using said second given communication protocol,

h/ processing said data and/or instructions by said remote server (4);

i/ generating by said remote server (4) (of) data characteristic of a configuration of said smart card (2) and/or of an application stored in said smart card (2), and for the transmission of said characteristic data to said terminal (1) using a third given communication protocol; and

j/ display of said characteristic data on a display screen (5) connected to said terminal (1) (see col. 2 lines 51-col. 3 lines 37).

As to claim 26, Kawan teaches a method according to claim 25, characterized in that, said request generating means is constituted by a web type browser (10), and further comprising storing in said remote server (4) in a third preliminary phase data constituting static display pages, and subsequent steps comprising transmitting upon reception of specific requests generated by said browser (10), all or some of said static display page data to said terminal in order to display pages of information associated with said smart card (2) on said display screen (5) (see col. 2 lines 51-col. 3 lines 37).

As to claim 27, Kawan teaches a method according to claim 26, characterized in that it further comprises generating, by means of said browser (10), in a fourth preliminary phase a particular request transmitted to a remote server connected to said internet network in order to download a particular piece of software called an applet into the browser (10), so as to automate all or some of said steps a through j (see col. 2 lines 51-col. 3 lines 37).

As to claim 29, Kawan teaches the method of claim 25 where the communication protocol is of the HTTP type (see fig. 10 and illustration).

As to claim 30, Kawan teaches a system architecture for remote control of a user station (1) communication protocol stack, said smart card reader (3) comprising a second communication protocol stack and said smart card (2) comprising a third communication protocol stack, allowing communications between said user station (1) and a remote server (4) connected to said network and communications between said

user station (1) and said smart card (2) via said smart card reader (3), said user station (1) also comprising means for generating requests (10) transmitted to said remote server (4), characterized in that said remote server (4) comprises a storage device (41, 42) for storing data and/or instructions allowing the generation of specific commands upon reception of specific requests originating from said request generating means (10) and their transmission to said user station (1), and in that said user station (1) comprises a specialized module (8) forming an interlace between said first and second protocol stacks and adapted to translate said specific commands received by said user station (1) in conformity with a first given communication protocol, into commands that conform to a second given communication protocol, in order to transmit them, using said second given communication protocol, via said smart card reader (3) to said smart card (2), so as to activate at least one given function of at least one application stored in said smart card (2) (see col. 2-col. 3).

As to claim 31, Kawan teaches a system architecture according to claim 30, characterized in that said remote server (4) further comprises an HTTP server (40), first storage device (42) for storing said data and/or instructions allowing the generation of specific commands, and second storage device (41) for storing data constituting display pages in HTML language (see col. 2-col. 3).

As to claim 32, Kawan teaches a smart card demonstrator (2), using the system architecture according to claim 30, said user station (1) comprising a display screen (5) for displaying data transmitted by said remote server (4) to said supplementary module (8) and characteristic data of a context of said smart card (2), using a third given

communication protocol, said characteristic data being generated by said remote server (4) upon reception of data sent by said smart card (2), using said second given communication protocol, translated by said supplementary module (8) and transmitted to said remote server (4) using said first given communication protocol (see col. 2-col. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan.

Kawan teaches a method according to claim 26, characterized in that it further comprises generating, by means of said browser (10), in a fourth preliminary phase a particular request transmitted to a remote server connected to said internet network in order to download a particular piece of software called an applet into the browser (see rejection of claim 27).

Kawan does not explicitly teach the limitation "applet is written in JAVA language". Official notice that one of the ordinary skill in the art at the time of the invention would be able to write the applet in Java Language.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- System And Method For Remotely Accessing User Data Records by Experton,  
U.S. Patent No. 5,995,965.
- Internet Loading System Using Smart Card by Davis et al., U.S. Patent No.  
6,105,008.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

July 14, 2004

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100